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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,101	08/26/2003	Bradley L. Todd	2001-IP-005443U2	6428

7590

09/09/2005

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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/650,101	TODD ET AL.	
	Examiner	Art Unit	
	Marc S. Zimmer	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22, 27 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 27 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/10/05 date</u> | 6) <input type="checkbox"/> Other: _____ |

Priority

It is noted for the record that Applicant may not claim priority to application serial no. 10,254,268 because this disclosure does not support the concept of a gel breaker comprising a degradable acid releaser. See page 17 of that disclosure.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4, 9, 11-16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al., U.S. patent # 5,224,546 for the reasons outlined in the correspondence dated November 29, 2004.

Applicant contends that the pH of the fluid taught by Smith "is not necessarily" lowered as acid is generated by the degradable, acid-forming component insofar as there are present pH adjusting materials that "could" counteract any reduction of acid produced by the esterified carboxylated chelator.

It is first noted that the materials mentioned as being pH adjustors may include acids which, of course, would not have any neutralizing effect upon the acid generated

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upon the degradation of said chelator. Even had the pH adjustor been a base, there would be a lowering of the pH commensurate with the amount of base consumed by way of reaction with the acid formed. In arguendo, this component is not even required of Smith's invention.

Claims 1-4, 7, 9-11, 14, 16-18, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Dawson et al., U.S. Patent # 6,793,018 for the reasons outlined in the correspondence dated November 29, 2004.

The mere fact that Dawson fails to expressly disclose a pH lowering is of no consequence. The Examiner has made a reasonable assertion rooted in chemical principals that there would be an inherent lowering of the pH of the servicing fluid taught by Dawson when the ester component is hydrolyzed to an acid. Applicant has not refuted this position but, rather, points out simply that this aspect is not expressly taught by the reference.

Claims 1-4 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris for the reasons outlined in the correspondence dated November 29, 2004.

Applicant acknowledges that the reference discloses an invention that is similar in the sense that the servicing fluid taught therein mentions an enzyme that catalyzes the formation of an organic acid from an acid precursor. Applicant attempts to distinguish the instant invention by pointing out that there is no need for an enzyme to promote formation of the acid. However, the claim is extremely broad as to the conditions under which the acid-releasing degradable material may be converted into an

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acid. Indeed, as the claim reads, degradation may be facilitated by any conceivable mechanism including the utilization of an enzyme as a hydrolysis catalyst.

Claims 1-2, 5-9, 12-16, 19-22, 27, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Nguyen, U.S. patent application publication no. 2005/0028976.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Nguyen discloses the preparation of particles of a multi-layer construct that may be added to fracturing fluids for the purpose of gradually releasing an active agent that is impregnated, coated, or otherwise adsorbed thereon. The particles have a receptive core that includes any of the materials mentioned in paragraph 14, said active agent including gel breakers, and a degradable top layer comprising any of the materials delineated in paragraph 19. It is significant that some of these materials to be employed as a degradable surface layer are the same as those contemplated by Applicant as embodiments of the acid-releasing degradable material. Of course, a fracturing fluid containing particles like those taught by Nguyen will inherently have its pH lowered as the materials of paragraph 19 are decomposed as these are the same as those disclosed in, for instance, claim 6.

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As an aside, the full scope of Applicant's claims is really quite remarkable and would be anticipated by any of a number of gel-based servicing fluids that comprise base-crosslinked gels and a gel breaker that is an acid precursor. Some other references teaching various embodiments of the claimed invention are Cantu et al., U.S. Patent # 4,957,165 and Himes et al., U.S. Patent # 5,363,916.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 6, 2005

Marc Zimmer
Marc Zimmer
AU 1712